

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CUSTOMER NO. 22927

Appellants: Jay S. Walker, James A. Jorasch, Russell Sammon, Stephen Tulley, and
Steven Santisi
Application No.: 10/685,143
Filed: October 14, 2003
Title: METHOD AND APPARATUS FOR OUTPUTTING A MESSAGE AT
A GAME MACHINE

Attorney Docket No.: 02-040

Group Art Unit: 3714
Examiner: Leiva, Frank M.

REPLY BRIEF

**BOARD OF PATENT APPEALS
AND INTERFERENCES**

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Appellants hereby submit remarks in this Reply Brief pursuant to 37 C.F.R. § 41.41 and in response to the Examiner's Answer mailed on February 4, 2009. This Reply Brief is submitted as a supplement to the Appeal Brief mailed on September 17, 2008 and should, if applicable, be considered as a request to maintain the current appeal to the Board of Patent Appeals and Interferences from the decision of the Examiner in the Final Office Action mailed March 19, 2008 (part of Paper No./Mail Date 20080116), rejecting claims **1-6, 21-26, 36-40 and 55-56**.

STATUS OF CLAIMS

Claims **1-6, 21-26, 36-40 and 55-56** are pending in the present application.

Claims **1-6, 21-26, 36-40 and 55-56** are being appealed.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims **1-6, 21-26, and 55** stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,942,574 to LeMay et al. (“LeMay” herein), or, in the alternative, as allegedly being obvious over LeMay.

Claims **36-40** stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,942,574 to LeMay.

Claim **56** stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over LeMay in view of Fuchs (US 6,126,541)(“Fuchs” herein).

REMARKS

I. No New Grounds for Rejection

Appellants note that the Examiner has not, in the Examiner's Answer mailed on February 4, 2009 (hereinafter the "Examiner's Answer"), altered or added any grounds of rejection with respect to the claims being appealed. Accordingly, this Reply Brief is submitted voluntarily pursuant to 37 C.F.R. § 41.41.

II. Incorrect Interpretation of the Art

The Examiner has presented additional verbiage to substantiate the assertion that U.S. Patent No. 6,942,574 to LeMay et al. ("LeMay" herein) discloses *outputting the message to a player via the game machine, the message comprising a recommendation of the feature [of the game machine]* as recited in claim **1 and 21**. Specifically, the Examiner recited LeMay as teaching "displaying a message on the display device notifying a player of the required indicia of credit amount (LeMay, col. 3:13-23)" while asserting that "LeMay discloses recommending to the player that for the feature their [sic] is a cost attached, thus informing of the pros and cons of the feature, the choice is left to the player to continue. (Recommend i.e.; to advice [sic] or counsel)." (Examiner's Answer, page 5).

Appellants respectfully assert the Examiner's recited definition is erroneous and, assuming, arguendo, the definition to be correct, merely serves to underscore the incorrect nature of the Examiner's assertions.

First, the most common usage of the verb "recommend" is "to present as worthy of confidence, acceptance, use, etc.; commend; mention favorably: *to recommend an applicant for a job; to recommend a book.*" (Dictionary.com). Appellants therefore note that, as is commonly understood, to "recommend" something is not to neutrally recite one or more attributes or characteristics of an object, but, rather, to recommend something is to commend the thing favorably or as worthy of confidence. Second, Appellants note that the third most preferred usage of "recommend" is "to advise, as an alternative; suggest (a choice, course of action, etc.) as appropriate, beneficial, or the like". (Dictionary.com). Appellants note that, while this usage

does include the word “advise”, the definition is not merely to advise as the Examiner suggests. Rather, it is to advise “as an alternative”. In short, to the extent that to recommend is to advise, it is to advise something as an alternative to something else. As a result, a recitation of a singular attribute, without reference to anything else, does not constitute recommending anything.

It is therefore evident that the Examiner is in error when stating that to recommend is merely to advise. However, when one applies the actual meaning of “recommend” to the Examiner’s analysis, it is evident that the Examiner is in error. Specifically, the Examiner is in error when stating that “LeMay discloses recommending to the player that for the feature their [sic] is a cost attached, thus informing of the pros and cons of the feature”. First, Appellants assert that any notification arising as a result of displaying a message on a display device notifying a player of a required indicia of credit amount is not a recommendation of anything. A recitation of an indicia of credit amount, or cost, is simply an advisement of an attribute of a feature, but, as there is no alternative suggested, such a recitation is most emphatically not a recommendation. Furthermore, advising a player that “the[re] is a cost attached” is most certainly not the act of “informing of the pros and cons of the feature” as the Examiner asserts. While a player may subjectively view the displayed cost as a pro or a con, this fact has no bearing on the self-evidently neutral nature of a display of a cost. As a result, LeMay’s displaying of the cost is most emphatically not a recommendation.

Appellants further wish to respond to the Examiner’s assertions regarding Appellants arguments beginning at page 18 line 23 of the Appeal Brief whereat Appellants stated “As noted above, the message of LeMay is displayed after the selection of the content. As it does not make sense to recommend a feature after the feature has been selected, it would certainly not be obvious to do so.” Specifically, the Examiner states that “the examiner points out above where the recommendation is about the feature and without selecting the feature the system would not know to advice [sic] on the price of the feature.” (Examiner’s Answer, page 8).

Appellants take no position on the veracity or logical consistency of the Examiner’s assertion except to note that, contrary to the Examiner’s assertion, displaying a cost is not a recommendation. Anything that is displayed only after selecting a feature can hardly be construed as a recommendation to select the feature in the first place, at least if one accepts the common understanding of time as moving in only one direction.

With regards to claim **55**, Appellants respectfully assert that the Examiner is in error when describing the teachings of LeMay vis-à-vis the recitations of claim **55**. The Examiner asserted “the examiner points to LeMay (col. 14:30-35) where it discloses that there is a plurality of conditions wherein at least, but not limited to a single condition to be satisfied prior to displaying content. LeMay discloses for example making a wager and that the wager be of a minimum amount, (first and second triggers). In addition appellant argues that the limitations of claim 55 are tide [sic] to or based upon the second trigger and that there is no second trigger; the examiner also points to (col. 3:20-23) wherein the message or feature is withheld till (i) receiving player tracking information and then (ii) allowing access based on the player tracking information, that constitute two places col. 14 and col. 3 where two or more conditions are necessary for the content to be displayed, that is not counting with identification and privileges of the player.” (Examiner’s Answer, page 9).

First, Appellants note that, contrary to the Examiner’s assertion, “making a wager” and “the wager be[ing] of a minimum amount” are not two triggers. A wager cannot be of a minimum amount unless the wager exists. As the wager exists resulting from the wager having been made, “making a wager” is entirely subsumed by the condition comprising “the wager be[ing] of a minimum amount”. Therefore, what the Examiner is asserting to be two triggers is, in fact, only one trigger. Second, the Examiner asserts that elsewhere LeMay teaches various other triggers. Appellants need make no assertions regarding the nature of such triggers except to note that claim **55** does not merely recite two triggers. Rather, claim **55** recites *identifying a message in a database of messages based on the trigger condition and identifying a game machine from among a plurality of game machines based on the message*. Appellants once again assert that LeMay nowhere teaches *identifying a message in a database of messages based on* any of the triggers asserted by the Examiner. Appellants further assert that LeMay does not elsewhere teach so doing based on any other trigger.

Appellants further respectfully assert that the Examiner is in error when describing the teachings of LeMay with respect to claims **36-39**. Appellants wish to reassert, generally, the arguments put forth in the Appeal Brief at pages 26-30 while specifically responding to the

Examiner's new assertions. The Examiner has newly asserted that, with reference to LeMay (col. 4:61-67), "[LeMay] explicitly discloses the message (the entertainment content), is presented in two different formats, as television programming and as Internet content, and such presentation is dependent to the characteristic of the player (sophisticated or unsophisticated), and wherein determining the representation is inherent if the system is capable of displaying the representations, the system has to determine them first." (Examiner's Answer, page 9).

In fact, the sum total of all that LeMay teaches and to which the Examiner refers to with references to all of the elements of claims **36 and 38**, at col. 4, lines 61-67, is the following:

Also, the television programming entertainment content may be displayed while a player is engaged in playing a game on the gaming machine or between games. Similarly, the entertainment content may include information available on the Internet, including the World Wide Web, for more technologically sophisticated players.

As is evident, LeMay simply teaches displaying a range of entertainment content whereby such content may "include information available on the Internet, including the World Wide Web, for more technologically sophisticated players". Therefore, while some content may be television programming and *other* content may be internet content, there is no teaching that both the television programming and the internet content are two different representations of the same thing, let alone the same message. Therefore, contrary to the Examiner's assertions, LeMay does not teach that "the message ... is presented in two different formats". Furthermore, while LeMay indicates that internet content may be more appealing to technologically sophisticated players, LeMay nowhere teaches that the format of the underlying content is determined based upon the sophistication of the player.

Lastly, with respect to claim **56**, the Examiner makes reference to Appellants' argument on page 34, line 6 of the Appeal Brief. Specifically, at the Examiner's citation, Appellants stated that "referring to Appellants statement that "Fuchs merely teaches informing a player of various probabilities related to future events that may be attained. Such information is prospective and is, quite obviously, not definitive. In contrast, claim **56** recites a message comprising *data indicating how a result of the gaming activity would have been different if the*

recommended feature had been activated during the gaming activity. Note that such data is backwards looking, (i.e., what would have happened) and is definitive”

Specifically, the Examiner states that “the examiner takes claim 55 to be a message ahead of the selection of the feature, and claim 56 is including with the message the possibilities of what will happened, since the message from claim 55 precedes the actual execution of the recommended feature.”

Appellants simply point out the following. Claim **55** explicitly uses the past tense when noting that the data indicates *how a result of the gaming activity **would have been different** if the recommended feature **had been activated** during the gaming activity.* It is therefore simply incorrect to interpret claim **55** as reciting a message comprising data indicating the “possibilities of what will happened [sic]” as asserted by the Examiner.

III. Conclusion

At least for the above-stated reasons, Appellants respectfully request that the Examiner's rejections of the pending claims be reversed.

Respectfully submitted,

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Date

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